

REMARKS

Reconsideration is respectfully requested.

Applicant notes that the drawings in this case have been accepted by the Examiner.

35 USC §112, 2ND PARAGRAPH

The Examiner has rejected Claim 19, under 35 USC §112, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Applicant has amended Claim 19 to correct the dependency of the Claim.

Applicant believes that all Claims, as amended, are now in proper order with respect to 35 USC §112, 2nd paragraph, and respectfully requests that all such rejections be withdrawn.

35 USC §102

The Examiner has rejected Claims 1-5, 8, and 16 under 35 USC §102, as allegedly being anticipated by Simon (US 6,497,444 B1).

The courts have ruled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Also, "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant has amended Claims 1-5 and Claim 8 to even more clearly distinguish applicants invention from the prior art.

Regarding Claim 1 and Claim 8, as amended, the Simon reference does not teach a golf cart shading system that may be laid out essentially flat when removed from the golf cart. Further, Simon does not teach a substantially rectangular system, as does Applicant. Applicant's substantially rectangular system has advantages over Simon in terms of ease of manufacture, reduced

cost, and more efficient compact storage of the system. It is therefore respectfully submitted that rejection of Claims 1 and 8 (and all Claims dependent therefrom) should be withdrawn.

Regarding Claim 2 and Claim 5, as amended, the Simon reference does not teach a golf cart shading system having an upper tensioner nor a lower tensioner. Fastener 45 of the Simon reference is not a tensioner. The primary definition of "tension" according to *Webster's Ninth New Collegiate Dictionary* is "the act or action of stretching or the condition or degree of being stretched to stiffness." Fastener 45 does not provide tension. Fastening and tensioning are not identical. Further, the Simon reference certainly does not teach a tensioner comprising elastic. It is therefore respectfully submitted that rejection of Claims 2 and 5 (and all Claims dependent therefrom) should be withdrawn.

Regarding Claim 3 as amended, the Simon reference does not teach a golf cart shading system having a lower attacher adapted to attach to an armrest portion of the golf cart. Further, Simon teaches against having anything attached to the armrest of the golf cart. The Simon reference [column 1, lines 54-57] teaches "There is no attachment to the Chassis. ... This does not engage any part of the framework, especially the side rails." It is therefore respectfully submitted that rejection of Claim 3 (and all Claims dependent therefrom) should be withdrawn.

Regarding Claim 4 as amended, the Simon reference does not teach a golf cart shading system having an upper attacher adapted to attach to at least one roof handhold portion of the at least one upper portion of the golf cart. Applicant's tied upper attacher is much more resistant to wind than Simons' Velcro roof attachment. It is therefore respectfully submitted that rejection of Claim 4 (and all Claims dependent therefrom) should be withdrawn.

Regarding Claim 16, Claim 16 depends from Claim 8. Applicant believes Claim 8 should be allowable and therefore Claim 16 should be allowable.

Applicant believes that all Claims, as amended, are now allowable with respect to 35 USC §102 and respectfully requests that all such rejections be withdrawn.

35 USC §103

The Examiner has rejected Claims 9-11 under 35 USC §103, as allegedly being unpatentable over Simon (US 6,497,444) in view of Conner (US 6,547,304).

Applicant repeats in full at this point by reference the entire above argument regarding the Simon reference.

The Federal Circuit has enunciated several guidelines in making a §103 obviousness determination. A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976)). (Emphasis added). For the Examiner to establish a *prima facie* case of obviousness, the Examiner must contend that the teachings from the prior art *itself* or that knowledge generally available to one of ordinary skill in the art would appear to suggest the claimed subject matter to a person of ordinary skill in the art.

It is well settled that to support an obviousness rejection, the prior art must contain some teaching or suggestion to make the modifications suggested by the Examiner. In this regard, the Federal Circuit has stated that "The mere fact that the prior art **may** be modified in the manner suggested by the Examiner does **not** make the modification obvious unless the prior art suggested the desirability of the modification." (emphasis added) *In re Fritch*, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992.) Applicant respectfully submits that no such suggestion exists in the Simon reference or the Conner reference to so modify or combine the elements to result in the Applicant's claimed invention. Furthermore, Applicant respectfully submits again that neither the Simon nor the Conner references teach nor suggest Applicant's claimed invention.

Simon does not teach or suggest the use of a viewer portion of the golf cart cover. Indeed, it is contrary to the spirit and teachings of Simon to have a particular viewer apparatus, because the Simon device is taught as being sufficiently transparent, throughout its entire surface, to permit the driver to see obstacles through the device. Simon teaches [column 3, line 5] "An opaque material is not suitable, because some transmissibility of image is needed for visibility."

For the above reasons it is respectfully submitted that rejection of Claims 9-11 (and all Claims dependent therefrom) should be withdrawn.

The Examiner has rejected Claims 6-7 under 35 USC §103, as allegedly being unpatentable over Simon in view of Jopp (US 6,701,948).

Applicant repeats in full at this point by reference the entire above argument regarding the Simon reference.

Simon does not teach or suggest the use of a holder for personal articles. Applicants respectfully point out that Applicant's use of a holder in combination with applicant's other limitations is new and non-obvious.

The Federal Circuit has stated: "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-84 (Fed. Cir. 1992.)

The Jopp reference has nothing to do with Golf Carts and is non-analogous art. Further, the Examiner has provided no suggestion or motivation to combine the references as suggested by the Examiner. If the Examiner persists with a rejection based on combining the Jopp and Simon references, Applicant requests that the Examiner provide evidence of the motivation to combine. It is therefore respectfully submitted that rejection of Claims 6-7 (and all Claims dependent therefrom) should be withdrawn.

Former Chief Judge Markey of the Federal Circuit has stated, "virtually all inventions are 'combinations', and ... every invention is formed of 'old elements' ... Only God works from nothing. Man must work with the elements." H.T. Markey, *Why Not the Statute?*, 65 J. Pat. Off. Soc'y 331, 333-34 (1983). Applicants respectfully point out that Applicant's use of a holder in combination with applicant's other limitations is new and non-obvious.

The Examiner has rejected Claims 12-15 and Claim 17 under 35 USC §103, as allegedly being unpatentable over Simon and Conner (US 6,547,304) in view of Jopp (US 6,701,948).

Applicant repeats in full at this point by reference the entire above arguments regarding the Simon reference, the Simon reference in combination with the Conner reference, and the Simon reference in view of the Jopp reference. There is no teaching or suggestion to combine the Simon, Conner, or Jopp references with each other. Applicant respectfully points out that Applicant's use of a viewer and a holder in combination with Applicant's other limitations is new and non-obvious.

Further, Simon does not teach or suggest the use of a sunlight controller, nor does it make sense to add one to Simon. Indeed, it is contrary to the spirit and teachings of Simon to have a particular sunlight controller apparatus, because the Simon device is taught as being sufficiently transparent, throughout its entire surface, to permit the driver to see obstacles through the device, while being sufficiently opaque to prevent sunburn.

For the above reasons it is respectfully submitted that rejection of Claims 12-15 and Claim 17 (and all Claims dependent therefrom) should be withdrawn.

The Examiner has rejected Claim 18 under 35 USC §103, as allegedly being unpatentable over Simon in view of Mills (US 4,098,536). And, The Examiner has rejected Claim 19 under 35 USC §103, as allegedly being unpatentable over Simon and Mills, in view of Connor. And, The Examiner has rejected Claim 20 under 35 USC §103, as allegedly being unpatentable over Simon and Mills, in view of Jopp.

Applicant repeats in full at this point by this reference the entire above arguments regarding the Simon reference, the Conner reference and the Jopp reference. Applicant respectfully requests that the Examiner provide evidence of motivation within the prior art to combine the Simon, Conner, Mills, and Jopp references as the Examiner suggests.

Further, Applicant has amended Claim 18 to even more clearly distinguish applicants invention from the prior art. The prior art does not teach a golf cart shading system that may be removed from the golf cart as one substantially rectangular piece which can be laid out substantially flat. It is therefore respectfully submitted that rejection of Claim 18 (and all Claims dependent therefrom) should be withdrawn.

Applicant believes that all Claims, as amended, are allowable with respect to 35 USC §103, and respectfully request that all such rejections be withdrawn.

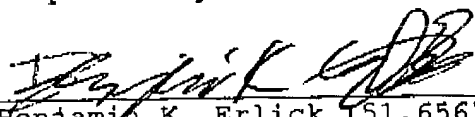
Applicant's combination, as presently claimed, is not taught or suggested by Simon nor any other of the cited references; and Applicant respectfully submits that the remaining Claims, as amended, are now in condition for allowance. Applicant has also carefully reviewed the other references cited herein, and respectfully submits that the present invention, as claimed by the remaining Claims, as amended, is clearly patentable over any of them or any combination of them.

If there are any fees incurred by this Amendment Letter, please deduct them from our Deposit Account NO. 50-1887.

Applicant also respectfully requests (not as a matter of form but as a special request in this case) that the Examiner, after having an opportunity to review this paper, grant a telephonic interview to Applicant's undersigned agent in order to discuss the application, the office action and this paper, to attempt to place this application in condition for allowance. Applicant's agent will contact the Examiner to collaborate on scheduling an appropriate time.

Respectfully submitted,

Date: July 20, 2004

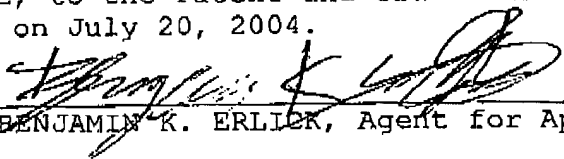

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted, via facsimile, to the Patent and Trademark Office fax number (703)-872-9306 on July 20, 2004.

Date 7/20/04

Signature:


BENJAMIN K. ERLICK, Agent for Appl.